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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/574,071 | 03/30/2006 | Gianluigi Cremonesi | 37387-402200 | 8701 |
| 27717 7590 11/13/2007 SEYFARTH SHAW LLP 131 S. DEARBORN ST., SUITE2400 CHICAGO, IL 60603-5803 | | | EXAMINER CRANE, DANIEL C | |
| | | | ART UNIT 3725 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,071

Applicant(s)

CREMONESI, GIANLUIGI

Examiner

Daniel C. Crane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 38 and 49-71 is/are rejected.
- 7) ☒ Claim(s) 27-37 and 39-48 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/30/2006 & 11/2/2006</u> | 6) <input type="checkbox"/> Other: ____ |

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BASIS FOR REJECTIONS

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

REJECTION OF CLAIMS ON FORMAL MATTERS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure fails to show that the opposite ends of the punch 1230 are locked inside the sleeve 1210. The original disclosure shows that the opposite ends of the sleeve 1210 are locked inside the middle support element 1200. Accordingly, the claim is unsupported by the original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24, 28, 30, 45-48 and 50-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With reference to claim 1, failure to provide antecedence for "upper support" and "lower support" (lines 4 and 5) renders the subject matter indefinite. As to method claim 50, it is unclear what constitutes the step of "forming sharing and boring...". Therefore the method claims have been examined as best understood. As to claim 19, failure to provide antecedence for "cup member" renders the claim indefinite. This claim has been examined as best understood. Claim 21 is dependent upon itself and, therefore, the scope of the subject matter is deemed indeterminate. The claim has been examined under the assumption that its dependency should be from claim 20. As to claims 23 and 48, reference to "it" renders the subject matter unclear. What specific element is "it" being referred to? Furthermore, failure to provide antecedence for "seat housing" and "boring means" renders the subject matter indefinite in claim 23. With reference to claims 28 and 30, failure to provide antecedence for "sleeve" renders the subject matter indefinite. As to claims 45 and 46, failure to provide antecedence for "boring punch" renders the subject matter indefinite. No antecedence is provided for "annular engraving surface" in claim 47. Further as to claim 46, failure to provide antecedence for "boring tip" renders the subject matter indefinite. As to claim 48, failure to provide antecedence for "boring means" and "seat housing" renders the subject matter indefinite. Use of the term "it" in claims 55, 56, 65 and 71 renders the subject matter vague. Use of the

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term “preferable” renders the subject matter vague. Because of the numerous antecedence issues with the claims, applicants’ attorney is required to correct the antecedence problems in response to this Office Action.

REJECTION OF CLAIMS OVER PRIOR ART

Claims 50, 51, 53, 54 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Duffield (3.061,908). See Figure 1 where the cartridge case is formed by three coaxial movement of a forming die set comprising element 52, punch 60, shear 24 and die 20. All of these components are moved to cooperate with one another to form the cartridge case.

Claims 56-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffield (3.061,908). Printing on manufactured goods is common in the manufacturing arts. Accordingly, to have provided printed features on the formed product as well known would have been obvious to the skilled artisan so as to label the product. Clearly, the type of material used in the method to form the case would have been within the purview of the skilled artisan having the benefit of known case materials within the cartridge art. Applicant has failed to show where this is critical to the overall process.

Claims 1, 13, 18, 21-24, 25, 26, 38 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bulso (5,024,077) in view of Glasner (1,849,670). Bulso illustrates an apparatus for forming a “cartridge” or container/shell/case C by a die set comprising an upper support element 10, 20, a fixed middle support element 30 having a means for shearing 31 and

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forming the case at 35 and a lower support element 32. The upper support element is movable relative to the lower support element and they are moved in predetermined sequences (see all the Figures). The drawing punch is shown at 12. While Bulso does not show that the upper support element is moved by guide columns, this provision is widely known in this art so as to maintain alignment of upper support element. This is shown by Glasner at 11 for this purpose.

Accordingly, it would have been obvious to the skilled artisan to have modified Bulso's die set by providing guide columns as taught by Glasner at 11 for the above noted motivation. Bulso's lower support element 32 is guided by column 33. The bottom support element 32 acts as an extractor that is provided with a spring loaded assembly 34 (see Figure 8). The specifics of the case have no impact on the structural make-up of the die set. Since the dependency of claims 21 and 22 is unclear, the rejection of the claims is included herein. This similarly applies to claim 23 because of the failure to provide any antecedence for the noted element (see the above 35 USC 112, second paragraph rejection).

INDICATION OF ALLOWABLE SUBJECT MATTER

Claims 2, 3, 5, 6-12, 14-17, 19-20, 52 and 65-71 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 27-37, 39-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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PRIOR ART CITED BY EXAMINER

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

RESPONSE BY APPLICANT(S)

Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(571) 272-4516**. The examiner's office hours are 7:00AM-3:30PM, Monday through Friday.

Documents related to the instant application may be submitted by facsimile transmission at all times to Fax number **(571) 273-8300**. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's Fax number is **(571) 273-4516**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR


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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCCrane
November 7, 2007



Daniel C. Crane
Primary Patent Examiner
Group Art Unit 3725